

2166

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Michael Loeb, et al.

: Group Art Unit: 2166

Serial No.: 09/940,062

: Attorney Docket No. 52846-5001-02

Filed: August 27, 2001

For: METHOD AND APPARATUS FOR
PROVIDING OPEN-ENDED
SUBSCRIPTIONS TO COMMODITY
ITEMS NORMALLY AVAILABLE
THROUGH TERM-BASED
SUBSCRIPTIONS

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INFORMATION DISCLOSURE STATEMENT
PURSUANT TO 37 C.F.R. §§ 1.56 ET SEQ.

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

In accordance with 37 C.F.R. § 1.97(b), the above-identified Applicants cite the following patents and publications, which may be material to the examination of this application and in respect of which there may be a duty to disclose in accordance with 37 C.F.R. § 1.56. In compliance with 37 C.F.R. § 1.98, and copies of the patents and publications set forth below and listed on the attached Form PTO-1449 (2 sheets) have not been provided because they were cited in patent applications 09/370,290 and 08/762,007, now U.S. Patent No. 6,014,641.

CERTIFICATE OF MAILING (37 C.F.R. § 1.8)

I hereby certify that this paper, and the papers and/or fees referred to herein as transmitted, submitted or enclosed, are being deposited on the date shown below with the U.S. Postal Service with sufficient postage as first-class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Name Alison B. Weisberg Signature [Signature]

Date of Deposit 12/14/01

<u>Patent No.</u>	<u>Issue Date</u>	<u>Patentee</u>
6,041,641	01/2000	Loeb, et al.
5,850,520	12/1998	Griebenow, et al.
5,903,877	05/1999	Berkowitz, et al.
5,995,092	11/1999	Yuen, et al.
4,799,156	01/17/1989	Shavit, et al.
5,168,445	12/01/1992	Kawashima, et al.
5,319,542	06/07/1994	King, Jr., et al.
5,475,585	12/12/1995	Bush
5,483,445	01/09/1996	Pickering
5,521,966	05/28/1996	Friedes, et al.
5,592,375	01/07/1997	Salmon, et al.

Other References

Bryant, Eric, "Make the library connection", Folio: The Magazine for Magazine Management, March 1994, Vol. 23, No. 4, pp. 33-34.

Cibbarelli, Pamela, "Cibarelli's surveys: user ratings of library subscription services", June 1995, Vol. 15, No. 6, pp. 29.

William H. Huff, "Serial Subscription Agencies", Library Trends, April 1976, Vol. 24, No. 4, pp. 683-709.

Jennifer Howland, "National Distributors: Scanning the Future", Folio Magazine, February 1985, p. 69.

Wally Wood, "Circulation Marketing: Let Your Magazine Do the Selling", Folio Magazine, June 1985, at p. 78.

Folio: The Magazine for Magazine for Magazine Management, "Titles Turn to Credit Card Billing", January 1, 1991, Vol. 20, No. 1, ISSN: 0046-4333, pp. 21.

Scott Donaton, "Magazines Set to Test Automatic Renewals", Advertising Age, January 7, 1991, News Section, pp. 6.

Echo Montgomery Garret, "Playing the Trump Card...", Folio's Publishing News, January 15, 1991, Vol. 3, No. 1, ISSN: 1043-8688, pp. 29.

John Masterton, "Titles Turn to Credit Card Billing to Boost Renewals; Circulation Insider", Target Marketing, February 1991, Vol. 14, No. 2, ISSN: 0889-5333, pp. C2.

Tony Silber, "No Automatic Acceptance for Autorenew; Periodical Subscription; Update", Folio The Magazine for Magazine Management, May 1, 1991, Vol. 20, No. 20, No. 5, ISSN: 0046-4333, pp. 13.

John Motavalli, "Amex Merger Talks Near End; American Express Publishing Co.", Inside Media, November 20, 1991, ISSN: 1046-5316, pp. 1.

John Motavalli, "Time and Amex discuss Merging Titles; Time Inc. Magazine Co., American Express Publishing Corp.", Inside Media, February 5, 1992, ISSN: 1046-5316, pp. 5.

Scott Donaton, "Amex will Revamp 2 Books; Talks on with Time Warner", Advertising Age, February 17, 1992, News Section, pp. 54.

Fred Pfaff et al., "Amex Shuffles Magazine Group; American Express Publishing Corp.", Inside Media, March 4, 1992, ISSN: 1046-5316, pp. 1.

John Motavalli, "Time Warner – Amex Talks at 'Highest Levels'; Possible Deal Would Bring Travel & Leisure and Food & Wine to Time Inc.; American Express Publishing Corp.", Inside Media, April 29, 1992, ISSN: 1046-5316, pp. 22.

Karen Burka, "Time, Amex Close in on Joint Venture: Time Inc.; American Express Publishing Corp.", Direct Magazine, January 1993, Vol. 5, No. 1, ISSN: 1046-4174, pp. 11.

John Motavalli, "Chuckling at Rumors...", Inside Media, January 20, 1993, ISSN: 1046-5316, pp. 28.

William Smith, "Can Atlanta's Premier Magazine About Culture, Food, Entertainment, Food, Celebrities, Food, Fashion, Food, Politics and Food Make It on a Greatly Slimmed Down Budget?", Georgia Trend, September 1993, Vol. 9, No. 1, Sec. 1, pp. 52.

Karen Burka, "Time Warner's New Slant on Magazine Subs", Direct, January 1994, Vol. 6, No. 1, pp. 12, ISSN: 1046-4174, pp. 12.

Eric Bryant, "Make the Library Connection", The Magazine for Magazine Management, March 1, 1995, Vol. 23, No. 4, pp. 33-34.

Pamela Cibbarelli, "Cibbarelli's Surveys: User Ratings of Library Subscription Services", Computers in Libraries, June 1995, Vol. 15, No. 6, ISSN: 1041-7915, pp. 29-34.

Cris Beam, "New Hope for Autorenewals, Automatic Magazine Subscription Renewals", Folio: The Magazine for Magazine Management, August 1, 1996, Vol. 25, No. 11, ISSN: 0046-4333, pp. 24.

Publishers Clearinghouse On-Line Magazine Ordering Entitled "Deal of the Day", Dated Thursday, March 6, 1997, (www.pch.com), 8 pp.

Folio: Publishing News, "Magazines report poor results in renewal service's tests: AutoReview automatic subscription renewal service," April 1992, Vol. 4, No. 4, Pg. 10, ISSN: 1043-8688.

Advertising Age, "Automatic Renewal Tests at Conde Nast," February 3, 1992, Pg. 10.

Folio's Publishing News, February 15, 1991, "Life After the Numbers Game, A Radical Rethinking of Circulation Economics and Strategies is Unavoidable, Says MPA's Bob Cohn; Magazine Publishers of America; NewsMaker; Interview", Vol. 3, No. 2, Pg. 27; ISSN: 10443-8688.

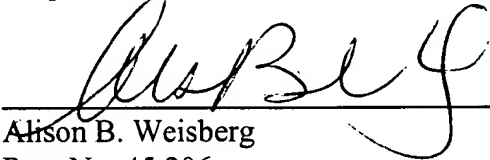
Elliott King, "Magazines Test 'Till Forbid' Programs; Automatic Renewals; Circulation Insider", Target Marketing, February 1991, Vol. 14, No. 2, ISSN: 0889-5333, pp. C2.

Applicants respectfully request that this item be considered by the Examiner, and that the Examiner acknowledge consideration of this reference by initialing and returning copies of the enclosed Form PTO-1449 with the next official action.

While this Information Disclosure Statement may be "material" pursuant to 37 C.F.R. § 1.56, it is not intended to constitute an admission that any patent, publication or other information referred to herein is "prior art" for this invention or otherwise material to the patentability of this invention as defined in 37 C.F.R. § 1.56.

In accordance with 37 C.F.R. § 1.97(g), the filing of this Information Disclosure Statement shall not be construed as a representation that a search has been made or that no other material information as defined in 37 C.F.R. § 1.56(b) exists.

Respectfully submitted,



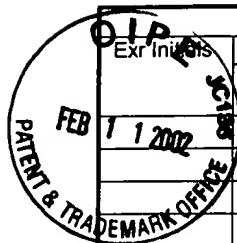
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Dated: _____

12/14/01

Substitute for form 1449A/PTO		Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)		Application Number	09/940,062
		Filing Date	08/27/2001
		First Named Inventor	Michael R. Loeb, et al.
		Group Art Unit	2166
		Examiner Name	Unassigned
Sheet <u>1</u> of <u>2</u>	Attorney Docket Number		052846-5001-02



U.S. PATENT DOCUMENTS			
Exr Initials	U.S. Patent Document Number	Kind Code (if known)	Name of Inventor or Applicant of Cited Document Date of Publication of Cited Document MM-DD-YYYY
	6,014,641		Loeb et al. 01/00/2000
	5,850,520		Griebenow et al. 12/00/1998
	5,903,877		Berkowitz et al. 05/00/1999
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FOREIGN PATENT DOCUMENTS					
Exr Initials	Foreign Patent Document			Name of Inventor or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY
	Country Code	Number	Kind Code (if known)		

OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS		
Exr Initials	Include Name of Author (in CAPITAL LETTERS), title of the article (where appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published	T ₁
	Bryant, Eric, "Make the library connection", Folio: The Magazine for Magazine Management, March 1994, Vol. 23, No. 4, pp. 33-34.	
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	Echo Montgomery Garret, "Playing the Trump Card...", Folio's Publishing News, January 15, 1991, Vol. 3, No. 1, ISSN: 1043-8688, pp. 29.	

T₁ - Place a check mark if English language translation is attached.

County Code - see Phila Doc #52886

Kind Code - see Phila Doc # 99754

1-PH/1527930.1

Substitute for form 1449A/PTO

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(use as many sheets as necessary)

Complete if Known

Application Number	09/940,062
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First Named Inventor	Michael R. Loeb, et al.
Group Art Unit	2166
Examiner Name	Unassigned
Attorney Docket Number	052846-5001-02

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Sheet 2 of 2

John Masterton, "Titles Turn to Credit Card Billing to Boost Renewals; Circulation Insider", Target Marketing, February 1991, Vol. 14, No. 2, ISSN: 0889-5333, pp. C2.
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